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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/585,788 06/05/00 KADE

B RE-001

EXAMINER

IM22/0629

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ART UNIT

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/585,788	Applicant(s) Brown et al.
	Examiner Lien Tran	Art Unit 1761
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --		
<p>Period for Reply</p> <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
<p>Status</p> <p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Feb. 20, 2001</u></p> <p>2a) <input checked="" type="checkbox"/> This action is FINAL. 2b) <input type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p>		
<p>Disposition of Claims</p> <p>4) <input checked="" type="checkbox"/> Claim(s) <u>1-4 and 8</u> is/are pending in the application.</p> <p>4a) Of the above, claim(s) _____ is/are withdrawn from consideration.</p> <p>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6) <input checked="" type="checkbox"/> Claim(s) <u>1-4 and 8</u> is/are rejected.</p> <p>7) <input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.</p>		
<p>Application Papers</p> <p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10) <input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.</p> <p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved.</p> <p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>		
<p>Priority under 35 U.S.C. § 119</p> <p>13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).</p> <p>a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:</p> <ol style="list-style-type: none"> 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). 		
<p>*See the attached detailed Office action for a list of the certified copies not received.</p> <p>14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).</p>		
<p>Attachment(s)</p> <p>15) <input type="checkbox"/> Notice of References Cited (PTO-892) 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____</p> <p>16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) <input type="checkbox"/> Other: _____</p>		

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1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.
2. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.
3. Claims 1-7 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

4. In the response filed Feb. 20, 2001, applicant states a new Reissue Declaration filed along with the response will correct the above defect. However, there was no Declaration found along with the response.
5. Claims 1-3 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. The claims do not include the limitation of proofing the bun portions for a third period of time of approximately three hours.

While the application contains a certificate of mailing with the date of June 1, 2000, certificate of mailing does not have any effect on the filing of the application to get a filing date.

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The filing date of the application is June 5, 2000 which is one day past the 2 year issue date of the patent.

6. In the response filed Feb. 20, 2001, applicant states that benefit is claimed to the Express Mail filing with certification on June 1, 2000. As stated above, the certificate of mailing does not have any effect on the filing of the application to get a filing date. The claims do broaden the patent claims because the proofing of approximately three hours is not in the instant claims.

7. Claims 1-4 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

The subject matter about baking the bagels added on page 2 to line 13 of page 3 was not in the original disclosure. The amendment on lines 22-25 on page 6 was also not in the original disclosure. The subject matter on lines 2-10 and 13-16 on page 7 was also not in the original disclosure. Applicant has not pointed out the support for these amendments in the original disclosure. There is nothing in the original disclosure that would lead one of skilled in the art to the newly added subject matter.

8. The reissue specification is objected under 35USC 132 because it introduces new matter into the disclosure. No amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The subject matter about baking the bagels added on page 2 to line 13 of page 3 was not in the original disclosure. The amendment on lines 22-25 on page 6 was also not in the original

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disclosure. The subject matter on lines 2-10 and 13-16 on page 7 was also not in the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office action.

9. In the response filed Feb. 20, 2001, applicant argues the subject matter added is a recitation of admitted prior art which by definition not "new matter". This argument is not persuasive. Any subject matter added to the specification and claim that was not disclosed in the original specification is considered new matter. Furthermore, some of the subject matter added by applicant is not discussion of prior art; instead, it is added as part of the disclosure and claim. Applicant states the characteristics added is a statement of expected result; there is no evidence to conclude in the original disclosure that the characteristics are expected result.

10. Claims 1-4 and 8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation of "omitting any partial baking step on any isolating planks on the deck of a commercial over" was not in the original disclosure. There is no disclosure about such omission in the original disclosure. The limitation of "deck baking said English muffin bagel" was also not in the original disclosure. The limitation of "a high-rise, light, English muffin bagel" was also not in the original disclosure. The limitation in steps c and d of claim 5 was not in the original

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disclosure. There is no discussion at all about the characteristics of the bagel in the original disclosure.

11. The rejection of the limitation “ omitting any boiling step” as being new matter is hereby withdrawn because applicant points out in the response the support for such limitation in the original disclosure. As to the limitations, the rejection is maintained. In the response, applicant states “ griddle “ is a satisfactory synonym for “ deck “. Applicant has not shown any evidence for this. Furthermore, there is nothing in the original disclosure about “omitting any partial baking step on any isolating plank on the deck of a commercial oven”.

12. None of the claim amendments complies with rule 1.121(b). Applicant needs to begin with the patent claims and makes the necessary changes using brackets and underlining. All subject matter being added to the patent claims must be underlined and all subject matter being deleted from the patent claims must be placed between brackets. Claims added to the patent must be underlined in their entirety.

13. Claims 1-4 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1: Line 3, “ kneadng “ should be ---kneading---. Step f is indefinite because the scope of the claim can not be determined; what would be considered as “ much greater”.

Claim 3 is indefinite. The body of the claim does not commensurate with the preamble. There is no recitation of steps of preparing bagel ingredients. Also, it is not stated what is being raised, or

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proofed or baked. In step c, the phrase “a very long proofing step” is indefinite because long is a relative term; what would be considered as very long? The term “light” is also indefinite because it is a relative term; there is no comparative basis.

Claim 8 essentially has the same problem as claim 3. Additionally the phrase “bagels expanding beyond standard bagel rising” is indefinite because what would be considered as “expanding beyond standard bagel rising”. There is not one uniform standard bagel rising. Bagels come in different sizes and height. The term “light” has the same problem as in claim 3. The phrase “texture intermediate the standard bagel and the standard English muffin” is indefinite because it is not known what is considered to be standard bagel and standard English muffin. The scope of the claim can not be determined.

14. The 112 second paragraph rejection is maintained because the claims still contain the same problem as previously cited in the last office action. The rejection of claim 8 is necessitated by amendment.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 1-4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the recipe for English muffins in the Boston Globe.

The recipe discloses the steps for making English muffins. The steps comprises mixing the ingredients to form a thick batter, letting the batter rise in a warm environment, stirring the batter down and letting it rise again. After the second rising the batter may sit for an hour or more. Griddle baking the batter to form the muffins. The newspaper also discloses a recipe for bagel.

The sitting of the batter after the second rising is equivalent to the claimed long proofing step. As to the bagel ingredients, the claims do not define what the ingredients are; the ingredients for the muffin are very similar to the bagel as shown by both recipes for bagel and muffin. As to coating with a layer of cornmeal, it would have been obvious to one skilled in the art to do so because this is commonly done with muffin. As to the feature of the bagel in claim 6, it can no be determined how the product is different from the standard bagel because the characteristics with respect to height, partially closed navel and skin are all relative. It is also common to vary the size or baked product; for instance, there are very big bagels and there are also small bagels or bagels in between big and small. It would have been obvious to one skilled in the art to vary the size. As to the kiss marks, this does not make the bagel to be different. This

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will inherently happen whenever any baked product is placed closed to each other during baking or proofing.

18. In the response filed Feb. 20, 2001, applicant argues the article discloses recipes for bagel and muffin as separate and that bagel is bagel and muffin is muffin. Applicant also argues the sitting of the English muffin batter is simply not equivalent to anything involved in making a bagel. There is no equivalent dough, rising sequence or suggestion to eliminate the boiling step. This argument is not persuasive. Bagel and muffin are different product in the art. However, the claims do not differentiate between the two product. In sum, the claims are directed to a baked product in which the steps are preparing a dough, kneading the dough, rising the dough for 3 times in which the third rising time is greater than the sum of the first and second rising times. The recipe for muffin discloses this sequence of steps. There is no boiling step for the muffin. Applicant also points out that the amounts of flour and yeast for bagel and muffin are very different. While this may be true, the claims do not define any amount to differentiate between bagel and muffin. The main ingredients for muffin are flour and yeast which are the same as the ingredients for bagel. The argument directed to claim 6 will not be addressed because the claim has been cancelled. As to the comment about the kiss mark, this will occur if the product is placed closed together during rising and baking, it is not seen how this differentiate the claimed product over the prior art product.

19. Applicant's arguments filed Feb. 20, 2001 have been fully considered but they are not persuasive.

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20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien Tran whose telephone number is (703) 308-1868. The examiner can normally be reached on Wed-Fri. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

May 4, 2001


LIEN TRAN
PRIMARY EXAMINER
